

Appl. No. 08/932,784
Reply Filed: January 30, 2006
Reply to Office Action of: July 28, 2005

REMARKS

In response to the Office Action of July 28, 2005, the Applicant submits this Reply. In view of the foregoing amendments and following remarks, reconsideration is requested.

Claims 1, 9 and 23 remain in this application, all of which claims are independent. No fee is due for claims for this amendment.

In the Office Action, claims 1, 9 and 23 were rejected.

The prior Office Action (November 3, 2004) in this application included a rejection of the claims in view of Washino II, Freeman and Osamu. This rejection was not repeated in the Office Action of July 28, 2005, and, accordingly, the Applicant understands that this rejection has been withdrawn.

Provisional Obviousness-type Double Patent Rejection

In the Office Action, claims 1, 9 and 23 were provisionally rejected for obviousness-type double patenting in view of U.S. Patent Application Ser. No. 10/897,506.

For expediency, the Applicant submits herewith a Terminal Disclaimer to obviate any nonstatutory double patenting rejection between this application and any patent that may issue from U.S. Patent Application Ser. No. 10/897,506. By submitting this Terminal Disclaimer, Applicant does not admit to the propriety of any nonstatutory double patenting rejection. *Quad Environmental Technologies Corp. v. Union Sanitary District* 946 F.2d 870, 20 USPQ2d 1392 (Fed.Cir. 1991).

Rejection Under 35 U.S.C. §103 in view of Peters and Kojima

Claims 1, 9 and 23 were rejected under 35 U.S.C. §103 in view of U.S. Patent 5,946,445 ("Peters") and U.S. Patent 5,168,363 ("Kojima"). The rejection is respectfully traversed.

According to Peters, a system stores audio and/or video material digitally such that it can be randomly and immediately accessed. See Col. 2, lines 17-21. In Fig. 1 of Peters, "analog video sources 1 and analog audio sources 2 are received by video coprocessor 3 and audio coprocessor 4." Col. 2, lines 30-32. "Each of the coprocessors digitizes incoming material and stores it on storage devices 5." Col. 2, lines 35-36. Such storage is "typically on a magnetic disk or in a computer memory." Col. 2, lines 18-19. Separate files are created in response to a discontinuity in the video information received. See Col. 2, lines 50-65. Fig. 1 illustrates that

Appl. No. 08/932,784
Reply Filed: January 30, 2006
Reply to Office Action of: July 28, 2005

sources of analog video received by the media recorder include such things as a video tape recorder, a video camera or a video assist of a film camera. See Fig. 1. "The storage of clips on disk . . . allows multiple clips to be played back in sequence." Col. 3, lines 32-34. The computer and video system in Fig. 1 can be designed for portability. See Col. 3, lines 43-45.

The Office Action asserts that Peters teaches "a means for specifying a sequence of still images". The claims, however, actually recite (using claim 1 as an example): "enabling the individual to specify a sequence of segments of the sequence of digital still images stored on the digital, computer-readable and writable random-access medium." *The assertion that Peters teaches a "means for specifying a sequence of still images" has nothing to do with the actual claim language.*

The Examiner acknowledges that Peters "fails to specifically teach that the motion camera mounted in the housing having the recorder. [sic]" Office Action, page 3, lines 18-19. It is probably more accurately stated that Peters teaches that a camera is separate from Peters' computer system that receives a video signal from that camera. The Office Action also fails to address the claim limitation of "enabling the individual to specify a sequence of segments of the sequence of digital still images stored on the digital, computer-readable and writable random-access medium," as noted above. Peters also fails to teach that a "motion picture camera" is mounted in the same "housing sized to be portable for use by an individual" that also includes both a "digital, computer-readable and writable random-access medium" and an "editing system" for "enabling the individual to specify a sequence of segments of the sequence of digital still images stored on the digital, computer-readable and writable random-access medium."

According to Kojima, in Fig. 1 and Col. 1, lines 5-10, Kojima relates to a "video signal processing apparatus *for use with* a video tape recorder (VTR) with a built in camera." See *Kojima*, Col. 1, lines 10-11, emphasis added.

The Office Action asserts that Kojima teaches "combining a camera with a recorder for making a portable apparatus is well known." *Final Office Action*, Page 3, lines 10-11. This assertion impermissibly generalizes the teachings of Kojima. Kojima teaches nothing more than the fact that it is common to have a video tape recorder (VTR) with a built in camera.

The Office Action asserts that it would have been obvious to combine the teachings of Peters and Kojima, by "providing a motion camera in the same housing of the digital recorder for portability's purpose therefore providing more advantages to the user in handling the apparatus

Appl. No. 08/932,784
Reply Filed: January 30, 2006
Reply to Office Action of: July 28, 2005

for capturing the pictures when needed.” Office Action, page 4, lines 2-4. Applicant respectfully disagrees.

The Office Action *does not set forth sufficient evidence* to support a prima facie case for combining of the teachings of Peters and Kojima.

For example, Kojima merely refers to a video tape recorder with a built in camera. The Office Action impermissibly generalizes the teachings of Kojima by extending it to all “recorders” (see Final Office Action, page 3, line 11 and page 6, line 5). There is no evidence in the record to support that one of ordinary skill in the art would have recognized such a generalized teaching in Kojima, or that such a teaching should be applied to computer systems that store data on a magnetic disk or in computer memory such as in Peters.

As another example, there is no evidence that one of ordinary skill in the art would have found it either desirable or feasible to replace the video tape recording functions in Kojima with the portable computer system described in Peters; or that one of ordinary skill in the art would have found it either desirable or feasible to combine a camera in the same housing as the portable computer system described in Peters. In particular, Peters teaches a computer that receives a video signal and stores video information in data files on a digital random-access computer readable and rewriteable recording medium, such as magnetic disk. Although Peters mentions receiving a signal from a camera, Peters does not teach or even suggest that the camera should be included as part of that portable computer system. Kojima merely teaches a camera combined with a video tape recorder, not a computer system. Thus, neither reference teaches combining a camera with a portable computer system such as shown in Peters.

The Office Action asserts that such a combination would have been made to “provid[e] more advantages to the user in handling the apparatus for capturing the pictures when needed”. *Final Office Action*, page 3, lines 15-16. Such an assertion is nothing more than a generalized statement of advantage, without regard to either the desirability or the feasibility of modifying the prior art and without any supporting citations to any authority. Because the assertion is made without any reference to any evidence to support it, it has not been demonstrated that these advantages and conveniences would have been apparent to those of ordinary skill in the art at the time the invention was made. Such assertions are thus nothing more than the Examiner’s subjective belief, and are not evidence. As noted by the Federal Circuit, “this factual question of

Appl. No. 08/932,784
Reply Filed: January 30, 2006
Reply to Office Action of: July 28, 2005

motivation is material to patentability, and [cannot] be resolved on subjective belief and unknown authority." *In re Lee*, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

Accordingly the rejection is traversed because the proposed combination is not supported by evidence of record.

The rejection also is traversed because some claims limitations were not addressed with respect to the proposed combination. As noted above, the Office Action asserts that Peters teaches "specifying a sequence of still images." The Office Action fails to address the claim language, which is (citing claim 1): "enabling the individual to specify a sequence of segments of the sequence of digital still images stored on the digital, computer-readable and writable random-access medium."

Accordingly, this rejection of claims 1, 9 and 23 is traversed.

It is also noted that the Office Action explains this rejection by first characterizing each reference by comparing it to the claim language, which is sometimes misquoted. For example, consider how the Office Action asserts that Peters teaches "a means for specifying a sequence of still images", instead of quoting the teachings of Peters directly. In turn, the proposed combinations of references are described as combinations of claim elements, not as combinations of the teachings of references. Thus, instead of making "particular findings . . . as to the reason the skilled artisan, *with no knowledge of the claimed invention*, would have selected . . . components for combination in the manner claimed," (*in re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000, emphasis added), the entire analysis of the collective teachings of the references is wrapped up in the claim language. Thus, the rejections are improper to the extent that factual findings regarding the collective teachings of the cited references rely on the claim language, sometimes misquoted, instead of evidence from the prior art.

Rejection Under 35 U.S.C. §103 in view of Bluth and Washino I

Claims 1, 9 and 23 were rejected under 35 U.S.C. §103 in view of U.S. Patent 3,617,626 ("Bluth") and U.S. Patent 5,537,157 ("Washino I"). This rejection is respectfully traversed.

This rejection is improper and should be withdrawn because neither Bluth nor Washino I, nor their combined teachings, teaches or suggests the limitations of the independent claims. In

Appl. No. 08/932,784
Reply Filed: January 30, 2006
Reply to Office Action of: July 28, 2005

particular, neither reference (alone or in combination) teaches or suggests any function, within a portable housing, for enabling an individual to specify sequences of segments of stored video.

In particular, the Office Action asserts, at page 4, line 9, that Bluth teaches a "housing sized to be portable for use by an individual," referring to Fig. 1 of Bluth. No such housing is shown in Fig. 1 of Bluth. Instead, Fig. 1 is referred to as a "system" throughout Bluth. There is nothing in Bluth that teaches or suggests that all of the components of this system, particularly editing, are found in a portable housing.

In the Final Office Action, the Examiner disagreed and asserted that "the electronic system must have a body and housing to cover and contain the circuits of the camera, recording/play back means and editing means." *Final Office Action*, page 7, lines 10-13. There is no evidence from Bluth to support this assertion. Further, it is more than plausible that each element in Fig. 1 of Bluth would have its own "housing" to cover and contain its own electronic circuits, so nothing in the architecture of Bluth's system would suggest that all of the components in Fig. 1 must be in a single portable housing.

The Final Office Action also asserts that Bluth "teaches the electronic system is a portable system since a recorded scene . . . can be played back immediately during shooting for monitoring." *Final Office Action*, page 7, 14-16. This assertion is a non-sequitur.

According to Washino I, Col. 6, lines 31-44:

"Fig. 2a shows a camera . . . A lens 2 and viewfinder 4 are mounted upon the body of the camera frame. The usual optical-splitter, CCD-sensors and driver circuitry, and . . . digital signal processing circuitry are located at 6 . . . The various analog and digital output signals and any input audio, video or control signals, all shown generally at 16, are interfaced through appropriate connectors disposed on the rear-panel 12 and sub-panel 14. Provisions are included a shown [sic] for the input of analog audio signals, and for the output of both analog and digital audio signals. . . . Internal video recording facilities 8 are described herein below."

Regarding the storage 8 in Fig. 2a, Washino I further states at Col. 8, lines 29-47:

"For this application, a data storage unit 8 is provided to facilitate editing and production activities, and it is anticipated that these units would be employed in much the same way as video cassettes are currently used in Betacam and other electronic news gathering (ENG) cameras and in video productions. This data storage unit may be implemented by use of a . . . disk drive with removable storage media, or by a removable disk-drive unit . . ."

Appl. No. 08/932,784
Reply Filed: January 30, 2006
Reply to Office Action of: July 28, 2005

Washino I states that editing functions are performed in a personal computer. In particular, Washino I states, at Col. 2, lines 45-51 (which is cited in the Final Office Action at page 2, lines 14-15), the following (with emphasis added):

"In the preferred embodiment, specialized graphics processing capabilities are included in a high-performance personal computer or workstation, enabling the user to edit and manipulate an input video program and produce an output version of the program in a final format which may have a different frame rate, pixel dimensions or both."

Washino I also states, at Col. 3, lines 54-60 (which is cited in the Final Office Action at page 2, lines 14-15), the following (with emphasis added):

"The system . . . allows an operator to control equipment . . . at a centralized personal computer to produce, edit and record a video program. Each camera to be used with the system . . . feeds a signal to the personal computer . . ."

The Office Action asserts that one of ordinary skill in the art would have combined the teachings of Bluth and Washino I "by using a processing means as taught by Washino for processing the motion picture from the camera into sequence of still images that can be recorded and read on and from a computer random access medium thereby enhancing the function of the apparatus of Bluth to facilitate accessing and retrieving the stored digital motion picture when needed." Final Office Action, page 4, last three lines to page 5 first two lines. No citation to any evidence regarding the desirability or feasibility of such a combination is provided.

Regardless of the propriety of the proposed combination of Bluth and Washino I, neither Bluth nor Washino I teaches a housing sized to be portable by an individual that includes both a motion video camera and a means that enables the individual to specify or define a sequence of segments of stored sequences of digital still images as claimed in claims 1, 9 and 23. Bluth fails to teach the claimed portable housing, and thus fails to teach a portable housing that includes a camera and functions for enabling an individual to specify sequences of segments of stored video. In Washino I, any housing that contains a camera does not contain functions for enabling an individual to specify sequences of segments of stored video.

Because neither Bluth nor Washino I teaches or suggest a "housing sized to be portable by an individual" that includes both a motion video camera and functions for enabling the individual to specify or define a sequence of segments of stored sequences of digital still images

Appl. No. 08/932,784
Reply Filed: January 30, 2006
Reply to Office Action of: July 28, 2005

as claimed in claims 1, 9 and 23, the rejection of claims 1, 9 and 23 in view of Bluth and Washino I is traversed.

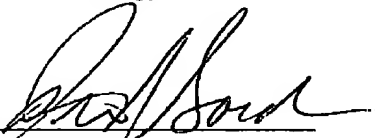
CONCLUSION

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this reply, that the application is not in condition for allowance, the Examiner is requested to call the Applicants' attorney at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicants hereby request any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, please charge any fee to Deposit Account No. 50-0876.

Respectfully submitted,

Avid Technology, Inc.

By 

Peter J. Gordon
Registration No. 35,164
Avid Technology, Inc.
One Park West
Tewksbury, MA 01876
Tel.: (978) 640-6789